

APPLICANT(S): ANGELEY, David G. et al.
SERIAL NO.: 09/814,443
FILED: March 22, 2001
Page 12

REMARKS

The present response is intended to be fully responsive to all points of objection and/or rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application is respectfully requested.

Applicants assert that the present invention is new, non-obvious and useful. Prompt consideration and allowance of the claims is respectfully requested.

Status of Claims

Claims 1-21 are pending in the application. Claims 20-21 have been withdrawn. Claims 11-15 have been objected to. Claims 1-19 have been rejected.

Claims 1, 3, 10, 11 and 16 have been amended. Claims 2 and 9 have been canceled without prejudice or disclaimer. In making this cancellation without prejudice, Applicants reserve all rights in these claims to file divisional and/or continuation patent applications.

Claim Amendment

Claims 3 and 10 have been amended in order to correct the number of the claim from which they are dependent. These amendments do not narrow the scope of the claims or create any prosecution history estoppel under *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., et al.*, 535 U.S. 722; 122 S. Ct. 1831.

APPLICANT(S): ANGELEY, David G. et al.
SERIAL NO.: 09/814,443
FILED: March 22, 2001
Page 13

Claim Objections

In the Office Action, the Examiner objected to claims 11-15 because of alleged informalities in claim 15. Applicants believe that the Examiner referred to an informality in claim 11, and accordingly Applicants amended claim 11 by replacing the term "there" with the term "thereof". In view of this amendment, Applicants respectfully request that the Examiner's objection to claims 11-15 is withdrawn. This amendment does not narrow the scope of the claim or create any prosecution history estoppel under *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., et al.*, 535 U.S. 722; 122 S. Ct. 1831.

CLAIM REJECTIONS

35 U.S.C. § 102 Rejections

In the Office Action, the Examiner rejected claims 1-3, 5, 7-9, 16, 17 and 19 under 35 U.S.C. § 102, as being anticipated by Nanaumi (US 4,653,495).

It is well established that in order to successfully assert a *prima facie* case of anticipation, the Examiner must provide a single prior art document that includes every element and limitation of the claim or claims being rejected. Therefore, if even one element or limitation is missing from the cited document, the Examiner has not succeeded in making a *prima facie* case.

Applicants respectfully traverse the Examiner's rejection of claims 1-3, 5, 7-9, 16, 17 and 19 under 35 U.S.C. §102 as being anticipated over Nanaumi. More specifically, the

Examiner noted that Nanaumi discloses a method of delivering laser energy to tissue "such that the output image from the exit-face of the lightguide uniformly irradiates the tissue."

Nanaumi discloses a laser medical apparatus comprising a plurality of square optical fibers 19 whose output sections are securely held together in a hand piece 21 (see column 5 lines 36-43 and Figs. 6, 8 and 9). The fibers disclosed by Nanaumi, as any optical fiber, must include at least a cladding layer in order to reflect the light transmitted therein. Therefore, the image projected from the end-face of such fiber must, by definition, be narrower than the outer diameter of the fiber. Accordingly, when combining together several fibers in a certain pattern in the manner disclosed by Nanaumi (see Fig. 9 of Nanaumi as an example of such pattern) the resulting irradiation pattern on the target plane must, by definition, include gaps and cannot be uniform.

Based on the above, Applicants respectfully assert that Nanaumi fails to teach or suggest, either expressly or inherently, at least the following elements:

"scanning said projected image so as to treat a continuous region of the tissue, said region having an area greater than the area of said treatment-spot" appearing in amended independent claim 1;

"scanning said beam so as to treat a continuous region of the tissue, said region having an area greater than the area of said treatment-spot" appearing in amended independent claim 16;

“during step (c) continuously moving said treatment-spot such that the region of tissue is about uniformly irradiated by the radiation delivered thereto” appearing in independent claim 17; and

“during step (c) delivering said sequence of spots in a pattern thereof such that the region of tissue is substantially uniformly irradiated by the delivered radiation”, appearing in independent claim 19.

Accordingly, Applicants respectfully assert that independent claims 1, 16, 17 and 19 are allowable. Claims 2, 3, 5, 7 and 8 depend, directly or indirectly, from claim 1 and therefore include all the limitations of this claim. Therefore, Applicants respectfully assert that claims 2, 3, 5, 7 and 8 are likewise allowable. Applicants respectfully request that the Examiner withdraw the rejections under 35 U.S.C. §102 to independent claims 1, 16, 17 and 19 as being anticipated over Nanaumi and to claims 2, 3, 5, 7 and 8, which depend therefrom.

35 U.S.C. § 103 Rejections

In the Office Action, the Examiner rejected claims 4, 6, 10-12, 14, 15 and 18 under 35 U.S.C. § 103, as being unpatentable over Nanaumi (US 4,653,495) in view of Buys et al. (US 5,336,217). Moreover, the Examiner rejected claim 13 under 35 U.S.C. § 103, as being unpatentable over Nanaumi (US 4,653,495) in view of Buys et al. (US 5,336,217) and further in view of Trost (US 5,743,902).

It is well established that in order to successfully assert a *prima facie* case of obviousness, the Examiner must provide a prior art reference (or references when combined) that either teaches or suggests all the elements or limitations of the claim or claims being

APPLICANT(S): ANGELEY, David G. et al.
SERIAL NO.: 09/814,443
FILED: March 22, 2001
Page 16

rejected (see MPEP § 2142). Therefore, if even one element or limitation is missing from the cited reference (or references when combined), the Examiner has not succeeded in making a *prima facie* case. It is further established that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination (see MPEP § 2143.01).

Based on the argument provided above with respect to the rejection under 35 U.S.C. §102, Applicants respectfully assert that Nanaumi fails to teach or suggest, either expressly or inherently, at least the following elements:

“scanning said projected image so as to treat a continuous region of the tissue, said region having an area greater than the area of said treatment-spot” appearing in amended independent claim 1;

“during step (c) moving said treatment-spot over said region of tissue such that said region of tissue is entirely irradiated with an about uniform intensity distribution of said radiation” appearing in amended independent claim 11; and

“during step (c) continuously moving said treatment-spot such that the region of tissue is about uniformly irradiated by the radiation delivered thereto” appearing in independent claim 17.

Furthermore, Applicants respectfully assert that neither Buys nor Trost teach or suggest, either expressly or inherently, these elements. Applicants further respectfully assert that the combination of Nanaumi, Buys and Trost fails to teach or suggest, either expressly or inherently, these elements.

Moreover, Applicants respectfully assert that in light of the structure of apparatus disclosed by Nanaumi, there is no motivation to combine it with either Buys or Trost. The Examiner cites Buys and Trost as references that disclose "plurality of lenses and moving the treatment spot via relative movement between the exit face of the lightguide and at least one lens" (Buys) and "the use of galvanometer mirror arrangements to move treatment spots in tissue irradiation apparatus" (Trost). However, the movement of the treatment spot according to Nanaumi is effected by the scanning unit 13 (see column 5 lines 24-35 and Fig. 6), which obviates the need for any lens or mirror system. Therefore, Applicants respectfully assert that Nanaumi does not include any teaching, suggestion, or motivation to combine the optical systems disclosed in either Buys or Trost, and in fact teaches away from the optical solutions presented in Buys and Trost for the purpose of moving the treatment spot.

Accordingly, Applicants respectfully assert that independent claims 1, 11 and 17 are allowable. Claims 4, 6, 10, 12, 13, 14, 15 and 18 depend from, directly or indirectly, claims 1, 11 and 17 and therefore include all the limitations of these claims. Therefore, Applicants respectfully assert that claims 4, 6, 10, 12, 13, 14, 15 and 18 are likewise allowable. Applicants respectfully request that the Examiner withdraw the rejections under 35 U.S.C. §103 to claims 4, 6, 10-12, 13, 14, 15 and 18 as being obvious over Nanaumi, Buys and Trost.

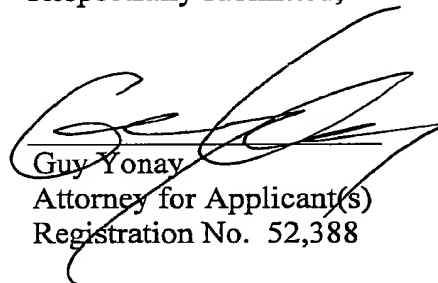
APPLICANT(S): ANGELEY, David G. et al.
SERIAL NO.: 09/814,443
FILED: March 22, 2001
Page 18

In view of the foregoing amendments and remarks, the pending claims are deemed to be allowable. Their favorable reconsideration and allowance is respectfully requested.

Should the Examiner have any question or comment as to the form, content or entry of this Amendment, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

Please charge any fees associated with this paper to deposit account No. 05-0649.

Respectfully submitted,



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Dated: December 16, 2003

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